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8 UNITED STATES DISTRICT COURT
9 NORTHERN DISTRICT OF CALIFORNIA
10 SAN JOSE DIVISION

11 UNILOC USA, INC.,
UNILOC LUXEMBOURG, S.A., and
12 UNILOC 2017 LLC,

13 Plaintiffs,

14 v.

15 APPLE INC.,

16 Defendant.

Case No.: 5:19-cv-01692-EJD

**NOTICE OF PLAINTIFFS'
OBJECTIONS TO MAGISTRATE
JUDGE'S REPORT AND
RECOMMENDATION RE
CONSTRUCTION OF CLAIMS OF U.S.
PATENT NO. 7,587,207**

1 On January 15, 2021, Judge DeMarchi entered a Report and Recommendation re
2 Construction of Claims of U.S. Patent. No. 7,587,207 (“R&R”) in this action. Dkt. No. 205.
3 Plaintiffs understand that under 28 U.S.C. §636(b)(1) or FRCP 72(a) the parties would have 14
4 days from entry of that order to file objections to it.

5 However, on January 26, 2021, this Court entered an order, Dkt. No. 207, staying this
6 action pending the appeal to the Federal Circuit from the decision in *Uniloc 2017 LLC v. Google*
7 *LLC* (Case No. 20-4355 and various related cases); this District’s decision regarding Uniloc USA,
8 Inc.’s and Uniloc Luxembourg S.A.’s lack of standing in *Uniloc USA, Inc. et al v. Apple Inc.* (Case
9 No. 18-358); and the District of Delaware’s decision regarding Uniloc USA, Inc.’s and Uniloc
10 Luxembourg S.A.’s lack of standing in *Uniloc USA, Inc. et al. v. Motorola Mobility LLC* (Case
11 No. 17-1658). Plaintiffs understand that order stays all proceedings with respect to any objections
12 to the R&R.

13 But because some case law suggests a failure to object within 14 days may preclude later
14 objection to the order, including appellate review, as a precaution Plaintiffs are filing this Notice of
15 Objections within the 14-day period.

16 Plaintiffs object to that portion of the R&R, at 10-13, limiting “inquiry message” to only a
17 “[message/messages] seeking a response to identify devices available for communication.”
18 Although that was the most prominent example of an “inquiry message” at the time the patent
19 application was filed, it was not the only one. By excluding other examples of “inquiry messages,”
20 including those described in the intrinsic record, the construction improperly limits the claim to
21 only the preferred embodiment. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005)
22 (en banc) (“[A]lthough the specification often describes very specific embodiments of the
23 invention, we have repeatedly warned against confining the claims to those embodiments.”
24 (Citations omitted)).

25 The R&R’s construction is the opposite of the one the Patent Office adopted during the
26 prosecution history. In its decision on appeal that resulted in the issuance of the patent, the Board
27 of Patent Appeals and Interferences did not limit its construction to the preferred embodiment, as
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1 did the R&R. Instead, the Board broadly construed “inquiry message” as a “message seeking
2 information or knowledge.” The Board ruled that a prior art patent (Whiteside) disclosed an
3 “inquiry message” when it described a billboard’s continuous broadcasting of a vendor’s telephone
4 number “because the message is implicitly seeking information (e.g., a response) from any
5 potential message recipients to call the phone number provided,” and “the continuous broadcast of
6 the vendor’s telephone number is a series of inquiry messages.” Dkt. No. 135-8, pp. 6-9.

7 The R&R’s construction limiting “inquiry message” to the preferred embodiment cannot be
8 squared with the intrinsic record. The message the billboard broadcast – an advertiser’s telephone
9 number – did not seek to identify devices for communication. It thus differed from the preferred
10 embodiment, and from the R&R’s recommended construction.

11 The R&R’s construction also conflicts with the stated purpose of the invention by reading
12 into the claim a requirement the invention was intended to eliminate. That is, the construction
13 seems to limit the claimed systems to those where the beacon and mobile device must be able to
14 communicate back and forth; by contrast, the patent discloses a system where data is transmitted
15 (broadcast) one-way—from beacon to mobile device—without any need for the beacon to identify
16 any devices for communication; or any need for the mobile device “to transmit any information
17 whatsoever.” *See* ’207 Patent at 8:4-9. A construction that limits the claims to systems where the
18 portable device can directly respond cannot be correct, because it excludes embodiments described
19 in the intrinsic record and defeats the stated purpose and benefits of the invention. *See, e.g.,* ’207
20 Patent at 2:26-30, 6:18-28, 6:37-48, 8:4-9, 10:5-16. Although an “inquiry message” is intended to
21 generate some form of response, any action or activity taken as a result of the portable device’s
22 receiving the message, even if the action is not a communication to the beacon itself (e.g., the
23 phone call in Whiteside), would fulfill the purpose of the claims.

24 Nevertheless, the R&R’s construction goes further, requiring not only that the mobile
25 device be able to provide a response to the beacon device, but also that the message sent by the
26 beacon be one “to identify devices available for communication.” Dkt. 205 at 10. This
27 construction is incorrect because it transforms the patented invention from one intended to avoid
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1 having to establish connections between devices for back-and-forth communications to one where
2 the message is intended to identify devices for that communication, even though that
3 communication is counter to the purpose of the invention. The R&R itself acknowledges that “the
4 stated purpose of the claimed invention [is] to allow a CA-device to obtain location information
5 from a beacon device without requiring the CA-device to join a network,” and that “a Bluetooth
6 handshake is not required for the invention to operate.” Dkt. 205 at 11, 12. The R&R’s ultimate
7 construction, however, contradicts those observations about the purpose and scope of the
8 invention.

9 The R&R’s reference to its construction as “supported by” Figure 4 and the accompanying
10 discussion in columns 6 and 7 of the patent, R&R at 12, is a *non sequitur*. Those portions of the
11 patent simply describe features of the preferred embodiment. All agree “inquiry message” would
12 be broad enough to cover the preferred embodiment; that is not the issue. Rather, the issue is
13 whether the claims should be *limited to* the “inquiry message” of the preferred embodiment.
14 Nothing in the cited portions of the patent suggests or even implies limiting “inquiry message” to
15 that specific example.

16 The thrust of the invention is a system where data can be transferred *without having to*
17 carry out the full inquiry process. *See id.*; *see also id.* at 2:26-30, 6:43-48. The R&R itself noted
18 that the invention is not limited to Bluetooth (Dkt. 205 at 12), which seems to run counter to its
19 ultimate construction. The Bluetooth-specific discussion on which the R&R relies as support for
20 its construction simply describes the preferred embodiment; it does not limit the scope of the
21 invention, and thus the R&R’s construction is incorrect. An inquiry message seeking devices for
22 two-way communications, as required by the that construction, *is not compatible* with one-way
23 broadcasting of location information—the heart of the patented invention—because the
24 specification notes that a beacon must be active continuously for fast location acquisition, which
25 “normally prevent[s] conventional two-way links being set up.” *See* ’207 Patent at 10:59-67. The
26 claims are not limited to messages that seek a response to identify devices available for
27 communication, as the R&R’s construction requires, and thus this construction is incorrect.

1 For the reasons stated above, Uniloc respectfully objects to the R&R with respect to the
 2 term “inquiry message” and urges the Court to adopt Uniloc’s proposed construction.

3 Uniloc also objects to the R&R’s construction of “Bluetooth messaging” and “Bluetooth
 4 protocols.” R&R at 13-15. As described in Uniloc’s earlier briefing, Dkt. Nos.121, 137, citing
 5 *SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F. 3d 870 (Fed. Cir. 2004), the term should be
 6 construed to include after-arising technology.

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 8 Dated: January 29, 2021

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